SUPREME COURT, U. S.

Supreme Court, U.S.
FILED
MAY 21 1974
MICHAEL RODAK, JR., C

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1590

DYNEX INDUSTRIAL PLASTICS CORP.,

Petitioner,

v.

ANCHOR PLASTICS COMPANY, INC.,

Respondent.

RESPONDENT'S BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

JEROME G. LEE
Attorney for Respondent
345 Park Avenue
New York, New York 10022

Of Counsel:
JAMES P. WELCH
MORGAN, FINNEGAN, DURHAM & PINE
345 Park Avenue
New York, New York 10022

May 22, 1974

TABLE OF CONTENTS

PAGE

Opinions Below 2

Questions Presented 3

Statutes Involved 3

Restatement of the Case 3

1. The Essential Nature of the Case 3
2. The Problem of Wrinkling and Distortion 4
3. The Performance Achievement of the Invention 6
4. The Patent Claims Are to a Process 6
5. The Trial Below 7

Argument

I—The first question presented by the petition, and the first reason asserted for granting the writ, raise routine fact questions of interest only to the litigants; they were rightly decided by the courts below 8

A. The first question presented and first reason asserted for granting the writ assert matters of no general importance 8

B. The courts below rightly decided the question of 35 U.S.C. 103 patentability 8

C. No conflict with the *Sinclair* decision 11

PAGE

II—The second "question presented" also raises a routine patent question rightly decided by the courts below; there is no conflict with the *General Electric* decisions 14

A. No general importance 14

B. The courts below correctly decided the merit of the invention over the prior art 15

C. No conflict with the *General Electric* cases 19

III—The third question presented (Pet. pp. 2-3) and the second reason presented for granting the writ (Pet. pp. 14-19) do not raise matters of general importance; the courts below correctly decided that the invention was not anticipated by the Nadeau patent 20

IV—The fourth question presented (Pet. p. 3) and the third reason asserted for granting the writ (Pet. pp. 20-22) do not fairly arise from the record 22

Conclusion 25

TABLE OF AUTHORITIES

PAGE

Cases:

General Electric Co. v. Jewel Incandescent Lamp Co., 326 U.S. 242 (1945) 14, 19

Graham v. John Deere Co., 383 U.S. 1 (1966) 14, 15, 20

H.M.L. Corp. v. General Foods Corp., 365 F.2d 77 (3d Cir. 1966) 23

Minerals Separation v. Hyde, 242 U.S. 261 (1916) 24

Preuss v. General Electric Co., Inc., 392 F.2d 29 (2d Cir. 1968), *cert. denied* 393 U.S. 834 (1968) 19

Sinclair & Carroll Co., Inc. v. Chemical Corp., 325 U.S. 327 (1945) 8, 11

Statutes:

35 U.S.C. §101 3

35 U.S.C. §102 ..... 3, 20

35 U.S.C. §103 ..... 3, 8, 14

35 U.S.C. §112 3

ABBREVIATIONS USED IN THIS BRIEF

Pet. p. —	Petition
Pet. Appx. — p. —a	Appendix to Petition
PX	Plaintiff Respondent's Trial Exhibit
DX	Defendant Petitioner's Trial Exhibit
App. —a	Joint Appendix, Volumes 1-5, containing pleading and trial testimony in appeal before Court of Appeals
App. E —	Two Joint Appendix Volumes containing exhibits in appeal before Court of Appeals

---

ll emphasis in this brief is ours, unless otherwise noted.

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1590

DYNEX INDUSTRIAL PLASTICS CORP.,

Petitioner,

v.

ANCHOR PLASTICS COMPANY, INC.,

Respondent.

RESPONDENT'S BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

The petition presents no sound reason why the writ should be granted.

There is no conflict between decisions of Courts of Appeals. There is no Federal question which has been decided in a way in conflict with any decision of this Court. Further, there has been no departure from the accepted and usual course of judicial proceedings. The case involves no significant constitutional question nor issue of substantial public interest.

This case is a routine action for patent infringement in which the patent has been held to be valid and infringed. The questions presented by petitioner Dynex are limited to validity and involve matters thoroughly considered by the District Court and adequately reviewed by the Court of Appeals.

The decisions below are right, and there is no sound reason why this Court should grant the Writ.

Additional review by this Court is of importance solely to the litigants and presents no substantial public question justifying exercise of certiorari jurisdiction.

Opinions Below

The opinion of the District Court for the District of New Jersey is reported at 363 F. Supp. 582 and is printed in Petitioner's Appendix A at page 1a.

The *per curiam* judgment order of the Court of Appeals for the Third Circuit affirming the judgment of the District Court is unreported but is printed in Petitioner's Appendix C at page 54a.

The *en banc* decision of the Court of Appeals denying rehearing is unreported but is printed in Petitioner's Appendix D at page 56a.

Questions Presented

Substantially none of the "Questions Presented" in the petition, pages 2-3, fairly arise in the instant record, and none whatsoever can be reached without reversing a substantial number of fact findings correctly made below.

Statutes Involved

The pertinent statutes are portions of the Patent Laws, Title 35 U.S.C. §§101, 102, 103 and 112 and are set forth in Petitioner's Appendix E at page 57a.

Restatement of the Case

Petitioner's statement of the case is inaccurate and incomplete. The facts are:

1. The Essential Nature of the Case

The patent in suit is U.S. Patent No. 3,136,676 dated June 9, 1964. It was issued to Richard Fisch (the inventor) and is assigned to Anchor Plastics Company, Inc., the respondent herein.

The patent in suit relates to thermoplastic extruding. In "thermoplastic" extruding, solid pellets of thermoplastic are fed into a hot extruder where they are melted into a formless mass. This molten thermoplastic mass then is forced by the extruder screw through a die. As the hot, melted thermoplastic emerges from the die it has the shape

of the cross-section of the die opening (App. 90a-96a). This extruded thermoplastic is immediately quenched by water to harden and set the thermoplastic in the new shape formed by the die (App. 90a-96a).

This quenching suddenly reduces the temperature of the extrusion about 300 degrees Fahrenheit (App. 99a-103a, 155a-158a).

The patent in suit describes and claims a process for extruding thermoplastic products with at least one visible region having a metallic appearance (PX-1; Appx. F, 64a).

A shiny and glossy appearance is attained by extruding a transparent thermoplastic about a metal foil, such as aluminum. The process produces a relatively inexpensive and attractive decorative trim that can be substituted for all brass or all aluminum products. The plastic product of the patented process costs only two cents or so a foot.

The all metal product costs two to four times as much (App. 226a).

Strips extruded by the process of the patent in suit are in widespread use as decorative trim on automobiles, home appliances and radio and television cabinets (App. 224a, 225a, 421a and 422a).

2. The Problem of Wrinkling and Distortion

Before the invention of the patent, such extruded products often had substantial defects. The "foil wrinkled so as to give the effect of an inferior product" (PX-1; Pet. Appx. F, p. 64a, col. 1, ll. 24-5).

The prior art thermoplastic extrusion process produced foil trim with wrinkling to such a severe degree that plaintiff's business therein came substantially to a halt in 1955 (App. 221a).

For a year and a half, employees of respondent, Anchor, tried without success to solve the problem (Pet. Appx. A, 4a, 32a, 33a). Respondent tried:

(a) Quenching with hot water, rather than cold water, to relieve the strains and distortions set up by cold water quenching (App. 112a-113a).

(b) Flame treating the metal foil to burn off residue on the foil and heat the foil to a temperature more compatible to the thermoplastic (App. 113a).

(c) Changing the extruding temperature to lower the viscosity of the thermoplastic so that the thermoplastic might flow around the foil and be softer (App. 114a).

(d) Annealed foil was used (App. 114a).

(e) The surface of the foil was roughened with a wire brush in an attempt to form a mechanical bond between the thermoplastic and the foil (App. 426a).

Attempts in the opposite direction by providing *slippage* to relieve strains between the metal foil and the thermoplastic material were also tried and failed:

(a) Applying a lubricant to the foil (App. 111a-112a).

(b) Using two foils, in face-to-face contact so that the foils might slip on each other (App. 114a-115a).

3. The Performance Achievement of the Invention

Finally, it was discovered by Richard A. Fisch, the inventor in the patent in suit, that by first applying a thin coating of one of four particular thermoplastic lacquers* to at least one surface of the metal foil and then extruding a transparent thermoplastic about the lacquer coated foil the problems of foil wrinkling and distortion were eliminated.

As soon as the invention was made in 1957, complaints from Anchor customers that the foil was wrinkling and distorting and the products were discoloring were no longer received (App. 127a-130a, 214a-216a, 223a).

The use of the process by respondent, Anchor, has been highly successful. From 1957 to the date of trial, Anchor's sales of products extruded with the Fisch process were over 3 million dollars and were still increasing (App. 223a-224a).

The patent in suit is licensed to General Motors Corporation, Glass Laboratories and Macoid Industries Inc. (Pet. Appx. A, p. 40a).

4. The Patent Claims Are to a Process

Claims 1, 2 and 3 of the patent in suit are directed to a *process.* (Petition p. 6, footnote 3).

The first step comprises providing a metal foil having a thin, film-like coating on at least one of its surfaces of

* "The foil 21-5 is coated with a thin layer of adhesive lacquer 26-5 which may have a base of cellulose butyrate, cellulose nitrate, ethyl cellulose, polyvinyl acetate-polyvinyl chloride" (PX-1; Pet. Appx. F, 65a, col. 1).

a transparent thermoplastic lacquer of one of four particular types, i.e., cellulose nitrate, cellulose butyrate, ethyl cellulose, and polyvinyl acetate-polyvinyl chloride lacquers.

The second step comprises extruding a transparent thermoplastic material about the lacquer coated foil while feeding the foil in unison with the thermoplastic material.

5. The Trial Below

The trial in the District Court lasted seven days and included courtroom demonstrations and presentation of exhibits in the fields of thermoplastic extrusion, infra-red spectroscopy and others (e.g. App. 90a-96a, 102a, 115a-119a, 121a-126a, 131a-132a, 140a-143a, 180a-184a, 611a-614a, 669a, 669a-783a, 761a-774a). Five witnesses testified and were extensively cross-examined. Three were experts.

The Trial Court's opinion (Pet. Appx. A, pp. 1a-51a) consists of forty-four pages and includes detailed findings of scientific fact. The opinion rests, in important part, on the credibility of witnesses. The Trial Court found that:

> "it was surprising and amazing that a strong bond was formed under the conditions of the patented process. * * * 'it is very amazing and surprising that after bending the product made by the patented process no wrinkling occurs.'" (Pet. Appx. A, p. 31a)

ARGUMENT

I

The first question presented by the petition, and the first reason asserted for granting the writ, raise routine fact questions of interest only to the litigants; they were rightly decided by the courts below.

A. The first question presented and first reason asserted for granting the writ assert matters of no general importance.

At page 2 and pages 10-14, the petition asserts that the Fisch process was not a patentable invention under the obviousness statute, 35 U.S.C. 103. This is the question raised by infringers in virtually all patent cases.

Petitioner's argument turns on the facts, which it has stated inaccurately and incompletely.

The petition asserts that the decision below conflicts with this Court's decision in *Sinclair & Carroll Co., Inc.* v. *Chemical Corp.*, 325 U.S. 327 (1945). This is incorrect. As we show *infra*, the courts below did nothing contrary to the *Sinclair* decision.

B. The courts below rightly decided the question of 35 U.S.C. 103 patentability.

The main attack of the petition on the Fisch invention as "obvious" under 35 U.S.C. 103 is premised on a straw-man argument using incorrect facts.

The premise is that the Fisch invention of the patent in suit solved a problem in the context of a product that

came apart. Because the product came apart, the petition argues, it was obvious to select a commercially available adhesive lacquer on the foil to keep the parts glued together (Pet. p. 11). This is incorrect. The Trial Court found:

> "The problem was not simply how to prevent wrinkling or delamination in a product but, instead, how to prevent it by a manufacturing process occurring in an environment of a high speed hot melt extrusion process, inside an extruder having the temperature of an oven, followed by a suddenly tremendous drop in temperature of over 300 degrees." (Pet. Appx. A, p. 31a)

The Trial Court considered and rejected Dynex's simplistic, hindsight argument in no uncertain terms:

> "Fundamental to defendant's prior art argument is its statement, with which I shall now deal, that the wrinkling problem met by the Fisch invention was actually a problem of delamination in which the aluminum foil and the transparent thermoplastic material came apart after completion of the extrusion process. Accordingly, to adhere these elements better to each other, defendant argues, it was obvious to use an adhesive to glue them together; and defendant sees this as so clearly indicated that it makes the contention initially even without specific prior art support." (Pet. Appx. A, p. 29a).

The Trial Court found, as a scientific fact, that wrinkling "is caused by factors during extrusion and is not synonymous with delamination" (Pet. Appx. A, p. 44a).

These findings are fully supported by the evidence. Witness Rothman demonstrated to the court that wrinkling and distortion of foil occurs *during* the extrusion process and without bending and delamination. An extruded prod-

uct showing such wrinkling and distortion caused during the prior art extrusion process was put into evidence as Court Exhibit 2 (App. 183a-184a).

This exhibit shows that "delamination" or "separation" is an extreme case and is not synonymous, at all times, with wrinkling and distortion. This is consistent with the admission of defendant's own expert witness, Dr. Skeist. He admitted that cigarette paper foil wrinkled when flexed even though there was perfect gluing (without separation) between the paper and aluminum foil (App. 646a). This physical exhibit (cigarette paper foil) is in evidence as PX-27 (App. 656a).

The evidence of Professor Bruins (App. 248a) also supports the Trial Court's finding that the problem was not wrinkling or delamination in a *product* that came apart but how to prevent wrinkling in a thermoplastic extrusion *process.*

The Trial Court correctly recognized that the "obvious" adhesive argument was simplistic hindsight. The Trial Court stated (Pet. Appx. A, p. 30a):

> "The simplicity inherent in hindsight is often misleading."

The Trial Court noted that the very material used in the hot melt extrusion process was itself an adhesive. The wrinkling and distortion problem occurred despite the fact that the transparent thermoplastic materials most commonly used were cellulose acetate or cellulose acetate butyrate (App. 433a-434a). These materials themselves have adhesive qualities or tendencies (App. 638a-639a).

Since the transparent thermoplastic material itself was adhesive, it was not obvious or even logical to use still another adhesive to glue it to metal foil. Why use glue B to adhere glue A to metal foil?

As the Trial Court stated:

> "Defendant's argument overlooks that the thermoplastic material used in the extrusion process itself had adhesive tendencies. It is understandable why one skilled in the art might not find it obvious to use in addition an adhesive to resolve the wrinkling problem." (Pet. Appx. A, p. 30a).

The petition ignores almost all of the physical exhibits and scientific evidence fully supporting the critical fact findings of the Trial Court. Those findings are clearly right. Petitioner's "obvious adhesive" argument has no merit.

C. No conflict with the *Sinclair* decision

Petitioner mistakenly relies upon *Sinclair & Carroll Co., Inc.* v. *Interchemical Corp.*, 325 U.S. 327 (1945). There, the patentee had developed a rapidly drying printing ink by merely selecting, from a list of solvents, a solvent known to have a desired boiling point. The solvent had no functional relationship to the printing ink involved. The invention was obvious.

Here, however, the four Fisch lacquers do have a functional relationship to the heart of the process. Inside the extruder, they mingle and blend into the molten thermoplastic mass and coact with it (App. 244a-245a).

Moreover, one cannot pick out the four Fisch lacquers from the commercial lacquers available without hindsight knowledge of the invention. They have no particular desired boiling point or other peculiar physical characteristic that distinguishes them from the thousands of other adhesive lacquers available. For example, the prior art *Alcoa* booklet lists "methacrylates, chlorinated rubbers and rubber polymers" (Pet. Appx. H, p. 81a) and "starch, casein, casein latex, sodium silicate, glucose and resin emulsions, to thermoplastics in organic solvents, waxes, asphalts and various formulated blends of these materials", "blends with gums and dextrines", "resins, plasticizers", "synthetic or reclaimed rubber", "asphalt, waxes", etc. (Pet. Appx. H, p. 82a).

The petition also relies (pp. 11, 12) on testimony of witness Bruins where he said it would be "obvious to try" various adhesives, including those named in the patent.

This testimony resulted from hindsight loaded questions. Professor Bruins was asked (App. 329a) whether there was any reason why one "could *not* use" in the process of the prior art Shanok patent (DX-Q, Pet. Appx. G, p. 69a) the particular *Fisch named adhesives* among the many in the prior art Alcoa article (DX-X, Pet. Appx. H, p. 70a). Once you know Mr. Fisch's answer to the wrinkling problem, it is true there is no reason why one could *not* try those four as well as all the many other adhesives of the Alcoa article in the process of the Shanok patent. Why not? Dr. Bruins was asked a second time whether one "would at least try" the four adhesives. Dr. Bruins correctly answered that one would try "as evidenced by the Fisch patent" (App. 329a).

However, the controlling statute, 35 U.S.C. 103, requires that the test of obviousness of an invention be made "at the time the invention was made". The statute is not concerned with hindsight.

Here, the Trial Court correctly found that, without hindsight, a skilled person would be confronted in the prior art not just with the four lacquers of the patent in suit but with hundreds, if not thousands, of adhesives that are not differentiated from the four Fisch lacquers:

> "Defendant's simplistic approach also omits to mention that the process in suit explicitly refers to specific lacquers; and it is clear that there is no statement in any prior art that these four specifically referred to lacquers would solve the wrinkling problem. The skilled person in the pertinent art would be confronted by hundreds, if not thousands, of adhesives, differing as to characteristics affecting their bonding ability. *See* Skeist Tr. 826-32." (Pet. Appx. A, p. 33a).

Based on all the foregoing evidence and specific findings, the Trial Court correctly concluded:

> "I thus conclude that, absent covering prior art, it was not obvious to the person of ordinary skill in the pertinent art to apply one of the Fisch lacquers to the foil of the Shanok process patent prior to introducing the foil into the extrusion apparatus" (Pet. Appx. A, p. 33a).

II

The second "question presented" also raises a routine patent question rightly decided by the courts below; there is no conflict with the *General Electric* decisions.

A. No general importance

Petitioner's second "Question Presented" raises essentially the same hindsight obviousness point as the first question. Petitioner argues that the invention was "obvious" under 35 U.S.C. 103* over three particular sheet lamination articles combined with the prior art Shanok patent (Petition, page 2).

At page 13, the petition complains that the District Court may have considered each of the three articles and the Shanok patent separately but never considered them combined:

> "The District Court apparently considered each of the heat-seal lamination prior art publications put in evidence by Dynex separately and never considered the *combined* teachings of the prior art Shanok '811 patent and the heat-seal lamination prior art." (original emphasis)

This matter of considering prior art in a patent case is well settled and requires no review by this Court. The controlling principles are clearly set out in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) and were carefully followed by the Trial Court in the instant case. In *Graham*, page 17, this Court stated the requirements as follows:

---

* 35 U.S.C. 103 appears at Pet. Appx. E, p. 58a.

> "Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained; and the levels of ordinary skill in the pertinent art resolved. Against this background, the obviousness or non-obviousness of the subject matter is determined."

Here, as we show below, the District Court carefully followed *Graham*. Each of the three sheet lamination articles were considered alone and combined with Shanok. All were made the subject of fact findings by the Trial Court (Pet. Appx. 15a *et seq.*).

B. The courts below correctly decided the merit of the invention over the prior art.

The main prior art relied on by Dynex is the *Shanok Patent No. 2,774,881* (DX-Q; Pet. Appx. G, p. 67a). It is the same Shanok patent that was considered by the Patent Office Examiner and the Patent Office Board of Appeals before the patent in suit was granted (PX-3, App. E420). The Shanok patent deals with extruding unlacquered metal foil in thermoplastic. As the Trial Court found:

> "There is no suggestion of a wrinkling problem • • • nor the solution of such a problem." (Pet. Appx. A, p. 37a)

It is worth noting that the Shanok patent was invented by the Shanoks of Glass Laboratories, Anchor's major competitor. Glass owns the Shanok patent but has taken a license to practice the patent in suit (Pet. Appx. A, p. 33a).

The three prior art sheet lamination articles relied on by petitioner Dynex are even further removed. None of

them are as pertinent as the prior art considered by the Patent Office.

The *Modern Packaging* article (DX-Z; Pet. Appx. J, p. 95a) is concerned only with laminating sheets and wraps and doesn't even mention extrusion processes. The Trial Court found:

> "* * * the Modern Packaging article entitled 'Aluminum Foil' (DX-Z), deals with laminating sheets and wraps, and not with the extrusion process. The article refers to laminating plastic films with aluminum foil and the necessity of selecting the proper adhesives therefor." (Pet. Appx. A, p. 35a)

The *Alcoa* booklet (DX-X; Pet. Appx. H, p. 70a) teaches that, in the art of lamination, one brings together two or more sheet-like materials and passes them between a pair of rollers. Sometimes an adhesive is used and sometimes it is not (Pet. Appx. H, pp. 76a-77a).

So far as wrinkling is concerned, the booklet's teachings *cause* wrinkling. The Trial Court found (Pet. Appx. A, p. 35a):

> "The Alcoa article deals with laminating of sheets and wraps. My own analysis of this article leads me to credit and accept the testimony of plaintiff's expert (Bruins Tr. 432):
>
> > 'This article deals entirely with the subject of lamination and gives no advice on how to make an extruded product containing aluminum foil.'
>
> Moreover, as the same expert pointed out, wrinkling is mentioned in the Alcoa article in connection with hot melt adhesives. Thus, as is stated, if hot melt adhesives are applied to aluminum foil, the article teaches

that you will have wrinkling rather than avoiding it, causing said expert to state (Bruins Tr. 431):

> 'If the hot melt adhesive were applied to the aluminum it would cause it to be expanded, due to the higher temperature, and if you now combined it with a cold sheet in laminating, you would get wrinkling.' "

The last of the three sheet lamination articles cited in the petition is *"Coating and Coating Methods for Aluminum"* (DX-BV; Pet. Appx. I, p. 92a). There are references to extrusion in this article (pp. 93a, 94a) but it occurs *before* contact with any foil. The lamination is done as usual between a pair of pressure rolls. It is not the process of the Fisch patent in suit where metal foil and hot melted thermoplastic are extruded in unison through a die giving shape and contour to the product.

As to this article, the Trial Court found:

> "The next of the defendant's prior art references is the 'Paper, Film & Foil Converter' article (DX-BV). This article is concerned with methods of application and coating techniques to aluminum foil. In the extrusion process described in this article, a sheet of polyethylene is first extruded and the extruded sheet is *then* brought into contact with the foil, *but the foil does not pass through the extruder at all* (Bruins Tr. 435-436). There is no mention of a wrinkling problem, much less the answer to the problem. Defendant also relies on this prior art for its disclosure of adhesives to be used with aluminum foil. Again, however, it is for this purpose not as pertinent as that before the Patent Office. As for the extrusion process discussed, this item of prior art is less pertinent than Shanok." (Pet. Appx. A, p. 36a).

The Trial Court found that the pertinent art to which the invention pertained under 35 U.S.C. 103 was the art of extrusion and not lamination:

> "The art, I find, which is pertinent is the art of extruding a thermoplastic material about a metal foil. I do not accept the proposition urged by the defendant, that the level of ordinary skill is that of the experts called in this trial, Dr. Bruins and Dr. Skeist. From the proofs offered, I find that one of ordinary skill in the pertinent art would not have talents, as the experts did, in chemistry, or have knowledge of the many techniques applicable to the manufacturing of plastics, such as lamination." (Pet. Appx. A, p. 39a).

The Trial Court nevertheless considered all the Dynex lamination articles together with the extrusion art and found that the Fisch invention was non-obvious and patentable:

> "Moreover, even if his knowledge [one of ordinary skill] extended beyon[d] the narrow confines of the extrusion art, I find he still would not have seen or heard any teaching or suggestion as to the solution of the wrinkling problem.
>
> Accordingly taking the defendant's starting point on obviousness, the Shanok and Chadbourne patents, and *adding to them* the accretions of knowledge provided by defendant's prior art adhesive theory, I find that the person of ordinary skill in the art would not have recognized that the problem of wrinkling, and distortion by bending stresses, could be cured by application to the foil of one of the lacquers included in the claims in suit." (Pet. Appx. A, pp. 39a-40a).

The Trial Court also found that there was substantial evidence confirming the merit of the Fisch invention and

showing that it was a valuable contribution to the arts. These findings included recognition of the invention by important companies who took licenses, such as General Motors, and by sophisticated workers in the art who took a license, such as the Shanoks of the Shanok patent. The Court also found that the invention went into widespread use and was highly successful and that even Dynex paid tribute to the invention by infringing the patent (Pet. Appx. A, pp. 33a and 40a).

C. No conflict with the *General Electric* cases

Petitioner Dynex's assertion of conflict between the decision below and this Court's decision in *General Electric Co.* v. *Jewel Incandescent Lamp Co.*, 326 U.S. 242 (1945) and the Court of Appeals' decision in *Preuss* v. *General Electric Co., Inc.*, 392 F.2d 29 (C.A. 2, 1968), *cert. denied* 393 U.S. 834 (1968), is misplaced. In both of those cases there were clear teachings or suggestions of the inventions in the pertinent prior art.

In *Jewel Incandescent Lamp Co.* the patent related to an electric lamp bulb having its interior surface frosted by etching. The prior art showed how to frost the inside surface as well as how to produce the claimed surface of rounded rather than sharp angular crevices or pits. The District Court found the invention to be obvious.

Similarly, in *Preuss* v. *General Electric Co., Inc., supra,* the patent related to a method of FM stereo radio transmitting and receiving. The Court of Appeals made the factual inquiries required by *Graham* v. *John Deere Co., supra,* and found that the invention of the patent was obvious.

In the instant case, the Trial Court made the factual inquiries of *Graham* v. *John Deere Co., supra,* and found that the invention of the patent in suit was not obvious. The Court of Appeals affirmed. There is no conflict.

III

The third question presented (Pet. pp. 2-3) and the second reason presented for granting the writ (Pet. pp. 14-19) do not raise matters of general importance; the courts below correctly decided that the invention was not anticipated by the Nadeau patent.

In essence, the petition argues that the invention of claims 1, 2 and 3 of the Fisch patent in suit is anticipated by the prior art Nadeau patent and that the courts below erred by reading distinguishing words into the claims to save them from invalidity for lack of novelty under 35 U.S.C. 102.

The legal principles controlling the question have long since been settled and the matter simply turns on the facts. The petition does not fairly state the facts.

Actually, in the courts below, no words were read into the patent claims in suit to distinguish them from the prior art Nadeau reference. The courts below gave ordinary meaning to the words already in the patent claims in light of the invention described in the specifications.

Each of the three claims in suit expressly call for:

> "extruding a transparent thermoplastic material about the lacquer coated foil while feeding the foil in

> unison with the thermoplastic material * * *" (Pet. p. 6, fn. 3)

A "thermoplastic", by definition, is a material that can be repeatedly softened by heat and hardened by cooling (App. 233a).

As can be seen, claims 1, 2 and 3 state that a "thermoplastic" material is extruded "in unison" with the lacquer coated metal foil. Moreover, the thermoplastic material is said to be extruded "about" the lacquer coated foil. The metal foil goes *through* the die opening along with the hot melted thermoplastic material. To go *through* the die, the thermoplastic material must be hot and melted (App. 237a-240a). Thus, as the expert witness explained, the claim means "that the lacquer-coated foil and the molten thermoplastic are simultaneously fed into the die" (App. 243a).

The process of the Nadeau patent (Pet. Appx. L, p. 121a) is entirely different. It is directed to the preparation of an aluminum printing plate!

The Nadeau patent is concerned not with hot molten extrusion but with cool extrusion of a coating onto the aluminum plate (App. 356a-357a, 407a, 408a). The aluminum does not go through an extruder die head (App. 407a). The Trial Court found:

> "Nadeau says little of extrusion. In Column 10 of the patent, Nadeau refers to various techniques that can be employed at room temperature for applying the coatings to his aluminum plate, and, in addition to room temperature spraying and dipping, Nadeau men-

tions extrusion. The testimony persuades me that the extrusion was vastly different from that of the Fisch patent. Thus, I accept the testimony of plaintiff's expert, Professor Bruins, that the Nadeau patent was concerned with solvent extrusion at room temperature to lay down a coating; that Nadeau means 'not molten extrusion, but merely toothpaste, room temperature extrusion'; and that the aluminum foil in the process of the Nadeau patent does not go through the die head of the extruder." (Pet. Appx. A, p. 13a-14a).

IV

The fourth question presented (Pet. p. 3) and the third reason asserted for granting the writ (Pet. pp. 20-22) do not fairly arise from the record.

The petition's last point is directed to the notion that the patent claims in suit are invalid because they cover an inoperative combination. According to page 21 of the petition, there was uncontested testimony below showing that use in the patented process of cellulose acetate as the transparent thermoplastic and polyvinyl acetate-polyvinyl chloride as the lacquer on aluminum foil did not work.

The petition asserts that the Courts below saved the patent claims in suit from invalidity by limiting the claims to exclude such inoperative combination.

Such contention is incorrect.

The only testimony about the alleged inoperative combination was the testimony of the petitioner's witness Skeist. This testimony was based on a single *ex parte*

experiment conducted on the very eve of trial and was hotly contested by cross-examination (App. 691a-710a).

The Trial Court listened to Skeist's testimony, observed his demeanor, and then rejected Skeist's testimony in this very area (Pet. Appx. A, p. 42a):

> "I reject Dr. Skeist's testimony and the conclusion he drew from his *ex parte* experiments. Starting with an evident bias * * *, he proceeded on a less than scientific basis using only three experiments and the aforementioned three plastics, [i.e., only one experiment with cellulose acetate] took only 20-30 minutes and obviously made no earnest effort to succeed."

The Trial Court went on at Pet. Appx. A, p. 43a to specifically accept the testimony of Dr. Bruins, respondent's expert, "that the patent sufficiently details the process in suit and does not place an unreasonable burden of experimentation on anyone who wishes to practice the invention."

In rejecting Skeist's credibility, the Trial Court acted well within the scope of its authority:

> "In any event, the trial Judge refused to credit Mr. Levins testimony on which this claim is largely based; and this, of course, was an issue which was peculiarly for his judgment."—*H.M.L. Corp.* v. *General Foods Corp.*, 365 F.2d 77, 82 (3d Cir. 1966).

There is substantial evidence supporting the Trial Court's finding. Skeist conceded that contrary to what a person skilled in the art would do, he did not try to make the process of the invention work. Instead he admitted that he was trying his best to make his experiment fail (App. 703a). For example, Skeist made no attempt to vary

the physical conditions of the experiment to see whether he could succeed (App. 691a-692a, 694a, 708a).

Indeed, Skeist did not even try the transparent cellulose acetate thermoplastic with the lacquer the patent said could be used therewith. The Fisch patent at column 3, lines 27-28 and 33-37 teaches the use of cellulose acetate thermoplastic with cellulose nitrate lacquer. Yet Skeist declined to try that combination because, he said, he was interested in failing rather than succeeding (App. 701a-703a).

Moreover, even if Skeist's "test" were to be credited, the patent would not be invalidated.

The patent and the claims do not teach or claim use of each of the four Fisch lacquers with *all* thermoplastics. Instead, the claim is concerned with use of "*a*" transparent thermoplastic and leaves it to a person skilled in the art to pick one that he prefers.

Dynex successfully uses its infringing combination of vinyl chloride-vinyl acetate type lacquer called VMCH in combination with cellulose acetate butyrate. The latter is a well-known transparent thermoplastic sold in commerce in large quantities (App. 434a).

This Court has held that the patent need only serve to "guide those skilled in the art to its successful application." *Minerals Separation* v. *Hyde*, 242 U.S. 261, 271 (1916).

The patent here teaches that cellulose acetate can be used with cellulose nitrate. Respondent itself commercially

used cellulose acetate successfully in practicing the invention (App. 477a-478a), and both respondent and petitioner have used vinyl chloride-vinyl acetate lacquers in their commercial operations. Skeist admitted that there were many combinations of thermoplastic and foil that *would* work with at least one of the lacquers taught by the patent (App. 710a).

Consequently, the courts below correctly rejected petitioner's contention that either cellulose acetate or vinyl chloride-vinyl acetate lacquers are inoperative in the process of the invention.

Conclusion

For the foregoing reasons the petition for a writ of certiorari should be denied.

Respectfully submitted,

JEROME G. LEE
Attorney for Respondent
345 Park Avenue
New York, New York 10022

Of Counsel:
JAMES P. WELCH
MORGAN, FINNEGAN, DURHAM & PINE
345 Park Avenue
New York, New York 10022

May 22, 1974